

## REMARKS

By this Amendment, the specification and Abstract were amended, claims 1-3 and 19 were amended, and new claims 20-22 were added. The specification (Summary of the Invention) was amended to be consistent with the amended claims. The specification (line 3, paragraph 2, on page 14) was amended to refer to FIG 2 rather than FIG 1. It is clear from, for example, the brief description of the drawings on page 7 that the flow chart in FIG 2 is being referenced rather than the schematic of FIG 1. The claims were amended to remove the terms “optionally” and “optional” to bring the claims in accordance with 35 U.S.C. 112, second paragraph. The basis for these amendments can be found on, for example, page 10, third paragraph to page 11, third paragraph. In claims 1 and 19, the order of the optional quotation steps and optional machine translation steps has been exchanged for consistency with the description. Claim 3 has been further amended to specify that if a machine translation is not suitable for a native language response of a recipient a quotation program may be applied to the response to generate a quotation for human translation of the response to the foreign language. The basis for this amendment can be found on page 13, paragraphs 2 and 3. New claim 20 is also directed to the possible courses of action that may occur in relation to the response by the recipient. The basis for this claim can be found on, for example, page 14, second paragraph. Support for new claim 21 can be found on, for example, page 10, paragraph 3, page 11, paragraph 3 and/or page 12, paragraph 2. Support for new claim 22 can be found, for example, on page 7 where it is specified that the invention is applicable to any form of electronic communication across a network. Hence, a communication may be sent to and from the same personal computer.

Section 112, second paragraph rejection. The Office Action rejected claims 1-19 under Section 112, second paragraph, on the grounds that the term “optionally” renders the claims vague and indefinite. Applicant submits that the term “optionally” does not automatically render a claim indefinite. MPEP 2173.05(h) expressly states that the term “optionally” may be an acceptable alternative format in patent claims. The term “optionally” is not acceptable only “where the list of potential alternatives can vary and ambiguity arises.” In this case, the potential alternative does not vary, but it is clear and definite. Therefore, the originally filed claims fully satisfied the definiteness requirement of Section 112, second paragraph.

Nevertheless, to reduce issues and advance the prosecution of this application, the term

“optionally” was deleted and replaced with more specific language defining the potential alternative. Applicant requests withdrawal of the rejection under Section 112, second paragraph.

Section 102(b) anticipation rejection. The Office Action rejected claims 1-3 and 12-18 under Section 102(b) as being anticipated by Shimazu et al. (JP 10269285). Applicant respectfully submits that Shimazu et al. neither discloses nor suggests the invention of the present application as claimed, and our arguments in support of this assertion are detailed below.

Shimazu discloses a document translation system in which the translation result together with the demanded charge is transmitted to the user. The database 104 stores a history of users’ previous language translation requests and the translation charge is adjusted with consideration to the contents of the past document translation requests. Initial and subsequent translation requests are compared to assess their degree of similarity to achieve a rational document translation charge.

In contrast, and with reference to independent claims 1, 13 and 19 and pages 10-14 of the specification, the present invention first identifies whether a translation of the communication is required and, if so, performs a machine translation of the communication. The present invention may also provide the recipient of the communication with an opportunity to accept a human translation by generating a quotation for the human translation. The communication and the machine translation, if required, and the quotation, if required, are all forwarded to the recipient.

Hence, the present invention makes decisions based on instructions of recipients to forward the most appropriate translation(s), thus necessitating the conditional “if...” statements in claims 1-3, 19, 20, and 21. Furthermore, in the present invention, a quote for a human translation may be forwarded to the recipient along with a machine translation to enable the recipient to determine whether the machine translation is sufficient, or whether it is worth accepting the quotation for a more accurate human translation. This is clearly not disclosed by Shimazu.

Firstly, Shimazu neither discloses nor suggests forwarding the original communication to the recipient. Secondly, Shimazu neither discloses nor suggests sending the quotation for a human translation of the communication before performing the translation. Instead, Shimazu teaches performing the translation, which is then sent with the demanded charge to the recipient. Thirdly, Shimazu neither teaches nor suggests only providing a machine translation, if required

by the recipient, or only providing the quotation for the human translation, if required by the recipient.

Hence, independent claims 1, 13, 14, and 19 are not anticipated by Shimazu et al. and the claims dependent on these independent claims are also novel. Withdrawal of the rejection under Section 102(a) is respectfully requested.

Section 103(a) obviousness rejection. In paragraphs 5 and 6 of the Office Action, claims 4-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shimazu et al. and Noriyuki (JP 10124516).

In view of the above arguments, Shimazu fails to disclose the claimed invention and therefore, a person having ordinary skill in the art could not combine the teachings of Noriyuki with the teachings of Shimazu et al. and achieve the subject matter of new claims 4-11. Hence, claims 4-11 are not rendered obvious by the combination of these citations. Withdrawal of the rejection under Section 103(a) is respectfully requested.

Applicant respectfully requests allowance of the pending claims. If there are remaining issues that can be clarified by telephone, the Examiner is requested to telephone the undersigned.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,



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## **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

### **In the specification:**

The paragraphs beginning at page 4, line 20 and ending at page 5, line 14 have been amended as follows:

determining if a translation of the communication to a second language is required by the recipient;

[optionally] applying a translation program to the communication to generate a machine translation if a translation of the communication to the second language is required by a recipient [of the communication to the second language];

determining if a human translation of the communication to the second language may be required by the recipient;

[optionally] applying a quotation program to the communication to generate a quotation for the human translation if a human translation of the communication to a second language may be required by the recipient [of the communication to a second language]; and

forwarding the communication and, if required, the machine translation and, if required, the [optional] quotation to the recipient.

In a further form, the method includes the steps of:

the recipient formulating a response to the communication;

identifying the response as a native language response to the foreign language communication;

[optionally] if required by the sender, applying a machine translation program to the native language response to generate a foreign language response;

[optionally] if a machine translation is not suitable, applying a [quotation program to the communication to generate a quotation for] human translation [of the communication to a second language] to the native language response to generate a foreign language response; and

forwarding the foreign language response to the sender.

In a further form the method includes the steps of:

the recipient formulating a response to the communication;

identifying the response as a native language response to the foreign language communication;

determining if a machine translation of the native language response to generate a foreign language response is required by the sender;

applying a machine translation program to the native language response to generate a foreign language response if required by the sender;

determining if a human translation of the native language response to generate a foreign language response may be required by the sender;

if a human translation of the native language response to generate a foreign language response may be required by the sender, applying a quotation program to the native language response to generate a quotation for the human translation; and

forwarding the foreign language response and, if required, the quotation, to the sender.

The paragraph beginning at page 14, line 9 has been amended as follows:

In some cases, it may be acceptable for the translation of the response from the recipient to be at the cost of the sender. In this case the process follows the flow chart of FIG [1] 2 as if the

response were an original communication.

In the claims:

Claims 1-3 and 19 have been amended as follows:

1. (amended) A method for automatic processing of electronic communication including the steps of:  
sending a communication from a sender in a first language;  
identifying the communication as a foreign language communication;  
determining if a translation of the communication to a second language is required by the recipient;

[optionally] applying a translation program to the communication to generate a machine translation if a translation of the communication to a second language is required by a recipient [of the communication to the second language];

determining if a human translation of the communication to the second language may be required by the recipient;

[optionally] applying a quotation program to the communication to generate a quotation for the human translation if a human translation of the communication to the second language may be required by the recipient [of the communication to a second language]; and

forwarding the communication and, if required, the [optional] machine translation and, if required, the [optional] quotation to [a] the recipient.

2. (amended) The method of claim 1 further including the steps of:  
the recipient formulating a response to the communication;  
identifying the response as a native language response to the foreign language communication;

[optionally] if required by the sender, applying a machine translation program to the native language response to generate a foreign language response; and  
forwarding the foreign language response to the sender.

3. (amended) The method of claim 2 further including the step of [optionally], if a machine translation is not suitable, applying a human translation [program] to the [communication] native language response to generate a [machine translation of the communication to the second language] foreign language response.

19. (amended) A computer in a networked computer environment, said computer programmed to perform the steps of:  
receiving a communication from a sender in a first language;  
identifying the communication as a foreign language communication;  
determining if a translation of the communication to a native language is required by the recipient;

[optionally] applying a translation program to the communication to generate a machine translation if a translation of the communication to a native language is required by a recipient [of the communication to the native language];

determining if a human translation of the communication to the native language may be required by the recipient;

[optionally] applying a quotation program to the communication to generate a quotation for the human translation if the human translation of the communication to the native language may be required by the recipient [of the communication to a native language]; and

forwarding the communication and, if required, the [optional] machine translation and, if required, the [optional] quotation to the recipient.

In the abstract:

The Abstract has been amended as follows:

A method and apparatus are described for automatic processing of electronic communications in a networked computer environment. The invention facilitates the appropriate form of translation of the communication to suit the circumstance. The communication is identified as a foreign language communication, a quotation program is optionally applied to calculate the cost of a human translation and a machine translation program is optionally applied to the foreign language communication. The communication, optional quotation and optional machine translation are forwarded to a recipient. The method is transparent to the sender and [reciever] receiver.